

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-21 remain in the application. Claims 8, 9, and 19 have been amended. Claim 19 has been amended to include the subject matter of claims 1 and 2.

In item 1 on page 2 of the above-identified Office action, claims 1-21 have been rejected as being indefinite under 35 U.S.C. § 112.

In a telephonic interview with the Examiner on February 14, 2006, the Examiner indicated, at the request of counsel, that he had discussed the above-noted rejection under 35 U.S.C. §112, with his supervisor. The Examiner indicated that upon reviewing the claims with his supervisor, the rejections under 35 U.S.C. §112 will not be maintained, with the exception of claims 8 and 9. The Examiner indicated that claims 8 and 9 would be rejected under 35 U.S.C. §112, because of a lack of structural relationship for the purging air openings and the sheet carrying airflows. Accordingly, claims 1-7 and 10-21 have not been amended. However, claims 8 and 9 have been amended to further clarify the claims and to facilitate

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

prosecution of the application. Therefore, the rejection of claims 8 and 9 is believed to have been overcome.

Furthermore, the Examiner indicated that he would send out an interview summary to this end. The above-provided comments are believed to meet the applicants' requirements for the summary of the interview.

In item 2 on page 3 of the Office action, claims 1-11, 14, 16-18, and 21 have been rejected as being obvious over Fujimoto (U.S. Patent Publication No. 2001/0011509 A1) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 19, and 21 call for, *inter alia*:

the air passage openings in the sheet-guiding surface forming opening cross-sections of the flow ducts, the opening cross-

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

sections being slots having a length and a width, the length being multiple times greater than the width.

The Fujimoto reference discloses a sheet guide unit for a sheet fed press. The sheet guide unit has a guide surface (1d) with numerous vents (4a and 4b) formed therein and facing opposite directions. The vents (4a and 4b) produce two streams of air, which originate at the vents and move in directions determined by the vents. An aspiration duct (3') is provided on the edges of the guide surface (1d). The aspiration duct (3') is not formed in the guide surface (1d). The air duct (3') is used to exhaust the streams of air produced by the numerous vents (4a and 4b) (page 2, paragraph 0018, and Fig. 8).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The reference does not show or suggest the air passage openings in the sheet-guiding surface forming opening cross-sections of the flow ducts, the opening cross-sections being slots having a length and a width, the length being multiple times greater than the width, as recited in claims 1, 19, and 21 of the instant application.

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

The Fujimoto reference discloses that vents are formed in the surface of a sheet guide. Aspiration ducts are disposed at the end of the guide surface. Fujimoto does not disclose that the aspiration duct is formed in the guide surface. This is contrary to the invention of the instant application as claimed, in which the air passage openings in the sheet-guiding surface form opening cross-sections of the flow ducts, the opening cross-sections being slots having a length and a width, the length being multiple times greater than the width.

The reference applied by the Examiner does not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, applicants respectfully disagree with the Examiner's allegation on page 4 of the Office action that "it would be obvious to one of ordinary skill in the art at the time of the invention, to provide the sheet-guiding surface (1d) of Fig. 8 with an air passage opening structure that properly controls the air flow ...". The Fujimoto reference teaches away from the Examiner's allegation. More specifically, Fujimoto discloses that "because the duct 3' is provided on the end of the guide surface, the air which is

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

blown across the width of the sheet along the surface 1d of the sheet guide unit will be drawn into aspiration duct 3'' (page 2, paragraph 0018). Accordingly, because Fujimoto discloses that the air provided by the vents must be blown across the width of the sheet, there is no motivation to move the aspiration ducts (3') into the guide surface. In fact moving the aspiration ducts into the guide surface would destroy the function of the Fujimoto reference as disclosed because the air would not be blown across the width of the sheet. Because the modification as suggested by the Examiner would destroy the function of Fujimoto, there is no motivation for providing the aspiration ducts in the guide surface.

Furthermore, the air passage openings that are provided in the guide surface as recited in the instant application are provided for blowing air. This is not the case in Fujimoto, which discloses that the aspiration ducts are used to remove the air blown from the vents (4a and 4b).

Therefore, based on the above-given comments, it is respectfully believed that the Examiner's allegation that it would be obvious to one of ordinary skill in the art at the time of the invention, to provide the sheet-guiding surface (1d) of Fig. 8 with an air passage opening structure that properly controls the air flow is not correct.

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed

Applic. No. 10/689,973
Amdt. dated February 17, 2006
Reply to Office action of November 17, 2005

on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61
USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully
believed that the evidence adduced by the examiner is
insufficient to establish a prima facie case of obviousness
with respect to the claims. Accordingly, the examiner is
requested to withdraw the rejection.

Since claim 1 is believed to be allowable over Fujimoto,
dependent claims 2-18 and 20 are believed to be allowable as
well.

Even though claim 19 is believed to be allowable, the
following further remarks pertain to claim 19.

It is noted that claim 19 was not rejected over the art.
Furthermore, Fujimoto does not show or suggest the use of a
throttle or restrictor disposed in a flow duct. This is
contrary to the invention of the instant application as
claimed, in which the flow ducts have guide vanes and
throttles or restrictors disposed therein.

It is accordingly believed to be clear that none of the
references, whether taken alone or in any combination, either

Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

show or suggest the features of claims 1, 19, or 21. Claims 1, 19, and 21 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-21 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.


Applic. No. 10/689,973

Amdt. dated February 17, 2006

Reply to Office action of November 17, 2005

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

February 17, 2006

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101